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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GORDON COOK and GRAEME FOLLETT

Appeal 2009-002395
Application 10/523,023
Technology Center 3600

Oral Hearing Held: July 21, 2009

Before FRANCISCO C. PRATS, MELANIE L. MCCOLLUM, and JEFFERY N. FREDMAN, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANTS:

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The above-entitled matter came on for hearing on Tuesday, April 21, 2009, commencing at 9:48 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Dawn A. Brown, Notary Public.

PROCEEDINGS

THE USHER: Calendar number 34, Mr. Michael Monaco.

JUDGE PRATS: Mr. Monaco, if you could spell your name or unless you've given her a business card already.

MR. MONACO: Monaco, the country, M-O-N-A-C-O.

JUDGE PRATS: Thank you.

7 MR. MONACO: I feel like a person in a strange land. Supposed to
8 be in the chemistry room. Electrical engineer arguing a mechanical that I
9 actually didn't write the brief on. But there will be no oligonucleotides or
10 enzymes. It is a very easy-to-visualize invention.

11 And there are a couple of important issues, I think, that are on the
12 record, maybe some issues that are not on the record. What is not on the
13 record is any kind of argument I haven't seen on either side for the old
14 means-plus-function, function, way, result, all that kind of stuff seems to not
15 even be discussed by the Examiner or by applicants' representatives. So
16 there is a whole bunch of issues here that I see when I pick this case up to
17 look at myself.

18 But if we focus on what is before us on the record, which is the issue
19 of the 102 rejection, the question is pretty simple -- well, kind of simple.

20 If we ignore the means-plus-function portion just for a moment and
21 look at the figures of our invention and the figures of the primary reference,
22 you'll see like in our figure 5, our figure 9, 10, and 13, that there is this gel or
23 component 10 that is inserted in this bladder that is able to be inflated with a
24 machine that sends pulsations at a predetermined rate.

25 And what is in the primary reference, if you look their figure -- for
26 example, figure 3, there is -- there are four air compartments. The

1 compartment that is receiving a mechanized pulsating air supply,
2 compartment 10, which leads into compartment 11. And there is nothing in
3 there that is a foam layer or any kind of gel.

4 JUDGE FREDMAN: But really, I mean, the argument it seems like
5 you're making is that it is different, but really the claim doesn't require which
6 compartment -- it doesn't have to be attached to a mechanized thing.

7 MR. MONACO: I was wondering about that. I tried to look to see if
8 I could figure that out myself because it says that we have the inflatable
9 bladder having the means to participate in the flow.

10 JUDGE FREDMAN: In other words, I guess the question is, why
11 can't -- the Examiner seems to be relying on chamber 9, which does have
12 this urethane foam layer in it, and I think it may be hard to argue, though
13 you may choose to, that that is not a volume-reducing internal component
14 because you have urethane foam in it.

15 Then the question which you jump to, and it is probably proper but it
16 is perhaps not something you want to argue too much because it doesn't
17 seem to have come up between either party previously, is, does the means
18 for providing intermittent pulses, could that be encompassing oral air
19 blowing, which is what chamber 9 receives, or does that simply encompass -
20 - is it required to encompass --

21 MR. MONACO: One second, sir. I'm not sure I heard you right.
22 You said chamber 9 arguably would be the one that was receiving the
23 intermittent time sequence?

1 JUDGE FREDMAN: Well, chamber 9, I think the Examiner -- that is
2 the chamber the Examiner is relying on. That is the chamber with the
3 urethane foam into which air is blown.

4 MR. MONACO: Orally.

5 JUDGE FREDMAN: Yes.

6 MR. MONACO: So chamber 9 cannot be a chamber that receives a
7 predetermined time sequence of pressure holding.

8 JUDGE FREDMAN: It is a product claim, right? It is not a method
9 claim. So we have to have a means for. Well, the means for can be the
10 person breathing in, in a sequential pattern. The means for is not defined in
11 the spec.

12 MR. MONACO: A predetermined time sequence.

13 JUDGE PRATS: If I could interject, I was looking at this another
14 way. It seems like the Examiner is saying that the overall structure is the
15 bladder. That is, the Examiner seems to be suggesting that it is not just you
16 have a bladder that has multiple chambers and a couple of the chambers
17 have this foam in them and, therefore, you have a bladder that contains these
18 volume-reducing components.

19 MR. MONACO: I think the Examiner is reading it a little too
20 broadly. I think the claim is clear that -- you know, if we go the whole
21 means plus function and what is the comparable structure, etc., etc., etc., I
22 think it becomes -- the rejection, it becomes weaker.

23 But even if we ignore that, in claim 1, we have a bladder. The bladder
24 has a means for dissipating during pressurization, and then there is another
25 means for providing intermittent pulses. First, the Examiner cites to coupler

1 4 for that, by the way. So the rejection doesn't do what you do, point to
2 number 9 anyway. So it would be a different rejection.

3 So if you take the rejection at face value, the -- what the rejection says
4 is the means for providing the pulse 4 goes into chamber 10, which has no
5 urethane. It is as simple as that. So just using basic 112 "the" versus "a," it
6 is not a good rejection.

7 JUDGE PRATS: If I could interject. If we could move – I think the
8 Examiner sort of elaborates a little bit more in his response to the Brief. If
9 you look at the sentence spanning pages 5 and 6 of the Answer, he makes
10 this inherency argument that -- which was kind of what I was trying to get
11 you to address, and I apologize for that. Maybe I should have pointed you to
12 that.

13 The Examiner says, however, it is inherent that the foam material 34
14 is a volume-reducing internal component located inside the bladder 6 and
15 taking up space therein. And the foam is a means for dissipating the flow of
16 fluid in the bladder, blah, blah, blah.

17 So it seems to be that the Examiner is saying, you know, the overall
18 bladder is structure 6 and 34 is inside that.

19 MR. MONACO: I follow you. And I don't know -- I forget my rules,
20 the details here, but isn't that a new-grounds rejection?

21 Inherency-based argument, that is not of record. That is not what
22 we're here to argue. He kind of made it up, you know, after the fact.

23 JUDGE PRATS: So this was not -- he wasn't arguing that until he
24 answered the arguments in the Brief?

25 MR. MONACO: Right. So number 1 is a new argument.

1 JUDGE MCCOLLUM: He does mention bladder 6 on page 3 of the
2 Answer. Now, I haven't looked back at the final rejection at the moment,
3 but it does say the inflatable bladder 6 right on -- in the first description of
4 the --

5 MR. MONACO: Yes, ma'am. Can I -- that is kind of what he is
6 getting at. I'm going to go back to the first one. The inherency thing is a
7 new argument.

8 JUDGE FREDMAN: I'm not sure that is true if you look at the final
9 rejection. He says clearly both inventions provide a foam head inside of an
10 inflatable bladder. Both foam heads are capable of performing the same
11 function.

12 I think that is a statement in the final inherency. He didn't maybe use
13 the word, but I don't think the magic words are --

14 MR. MONACO: The whole inherency argument, why it is not
15 necessary, blah, blah, blah, blah. So to me, it is not of record. But if you
16 guys think it is, I guess we can take it on the chin and say it is.

17 But back to your other point, going back to just basic 112-basis issues,
18 the way the claim is -- claim 1 is written again, we have the bladder with the
19 means for dissipating, dissipating during pressurization.

20 And means for providing the pulses -- we have in a time sequence, in
21 the time sequence, the only time sequence that is described, and again in the
22 rejection, it is pointed to, is the time sequence that comes in through
23 coupling 4 into bladder 10.

1 So that doesn't do it. That time sequence to bladder 10 or void 10
2 maybe -- exists and there is nothing in void 10 and there is no connection
3 between 10 and 8. I'm not --

4 JUDGE FREDMAN: Nine I think it is.

5 MR. MONACO: The other two chambers. There is a connection
6 between 10 and 11 through this restricter tube 12 so -- and I inherited this
7 but I don't think it is a good rejection. I think the claims could be certainly
8 done a lot better.

9 I think that the record is not very well developed. The whole means-
10 plus-function argument is not even there. Where is the structure? You
11 know, where is the support? How do you interpret a structure? None of that
12 is developed here.

13 But I think -- I mean, personally think it needs -- I don't know how
14 you guys do your job -- but sent back down to the Examiner and say you've
15 got to start from the beginning looking at how do you interpret a means-
16 plus-function claim for one.

17 And number two, the rejection, again, he dug his own hole by
18 pointing to coupler 4. He never points out this self-sealing valve 9A as
19 providing the intermittent pulses. And from a 112 Second perspective, basis
20 perspective, he doesn't have it.

21 Now, a 103 rejection, who knows. You know, this is a 102 rejection
22 and because it is 102, it has got to be pretty literal.

23 I also want to point out something in independent claim 10. Here the
24 means for controlling fluid flow, blah-dee-blah, by having an -- by varying

1 an internal volume of inflatable chamber. And again, I went to the
2 specification to try to look -- what are they going to get through here?

3 And I'm looking at channel 11. Channel 11 is described as a way to
4 vary internal volume. There is nothing in channel 11. It really comes down
5 to how do you interpret -- what is the supporting structure? What is it trying
6 to do?

7 JUDGE FREDMAN: Could you just briefly discuss -- one of the
8 claims that I think is a little different is the claim 6.

9 MR. MONACO: Claim 6?

10 JUDGE FREDMAN: Versus the other claims where there is some
11 argument.

12 MR. MONACO: One second.

13 JUDGE FREDMAN: To the extent we have a teaching in Johnson
14 that you may or may not agree teaches the bladder with the foam in it, you
15 know, what is your view on the obviousness with the issue that has air-flow
16 channels, I guess?

17 MR. MONACO: I apologize. I didn't come prepared to talk about
18 that. What I would like to talk about the dependent claims, though, is the
19 rejected claims 3 and 11. The issue there – you know, Gorman is an air-
20 mattress flotation support system. And in our invention and the primary
21 reference there, they have to deal with, you know, human bodies. That can't
22 be a reasonable -- a rational combination.

23 I mean, why not just pick something that inflates balloons when you
24 land a spacecraft in the ocean? It can't be any inflatable thing on the planet.
25 It has to be somewhat related. Why would anybody go look at a mattress

1 when they're looking at deep vein edema devices or something like that. So
2 that can't be a reasonable or rational rejection.

3 So anyway, I think that if, you know, progress could be made towards
4 allowance by having a better set of rejections and then perhaps for a better
5 set of claims to get where we're going. I don't think that these rejections are
6 good but that is it.

7 I think we have some 112 issues that kind of doom the rejection. And
8 for 103, you know, we wouldn't be here. And if they had developed the
9 record under means-plus-function on both sides, we might not be here. But
10 the basic support for the features, and the Examiner is only pointing to
11 coupler 4.

12 JUDGE MCCOLLUM: I'm not seeing the Examiner pointing to 4 so
13 much. Where?

14 MR. MONACO: It is in the final rejection.

15 JUDGE MCCOLLUM: Oh, the final.

16 JUDGE FREDMAN: I don't see it in the Answer at least.

17 JUDGE MCCOLLUM: Yeah.

18 JUDGE PRATS: Any further questions?

19 JUDGE MCCOLLUM: I don't think so.

20 JUDGE FREDMAN: I don't think so.

21 JUDGE PRATS: Anything further, sir?

22 MR. MONACO: No. I'd welcome any feedback you've got on the
23 situation. Thanks so much.

24 JUDGE PRATS: Thank you.

25 (Whereupon, the proceedings at 10:03 p.m. were concluded.)